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09/837,193	04/19/2001	Masahito Adachi	NEG-206US	1190

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.  
11491 SUNSET HILLS ROAD  
SUITE 340  
RESTON, VA 20190

EXAMINER
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HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,193

Applicant(s)

ADACHI, MASAHIRO

Examiner

Peter K. Huntsinger

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/19/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/03</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 9/23/03 was filed after the mailing date of the application on 4/19/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 8-10, 13, 14 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gacek.

Referring to claim 1, Gacek discloses an information providing system comprising: a printer (printer 324 of Fig. 3); a user terminal (STB 322 of Fig. 3) connected to said printer and sending print information to said printer (col.15, lines 53-62); and an information providing server delivering information via a communication line (3<sup>rd</sup> party merchant, col. 9, lines 28-32), wherein said printer comprises: means for acquiring the information delivered from said information providing server, said means for acquiring the information being connected to said information providing server via the communication line (S601-S604, Fig. 6A); means for printing the acquired information according to a print instruction received from said user terminal (col. 15, lines 58-62); and means for notifying an amount of information acquired from said information providing server and printed (col. 13, lines 9-11), wherein said user terminal comprises: means for sending a print instruction to said printer (col.8, lines 52-58); and means for setting a print format of the information (col.8, lines 52-58), which is acquired from said information providing server (col. 15, lines 27-33), in said printer, and wherein said information providing server comprises: means for calculating a total of the amount of information notified by said printer (col. 13, lines 11-16).

Referring to claim 2, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information is acquired from said information providing server (S615 in Fig. 6B, col. 15, lines 55-58).

Referring to claim 3, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information acquired from said information providing server is updated from the information acquired last (S409-S410, col. 14-15, lines 58-67, 1-20). The print job disclosed by Gacek is considered updated information when the print job differs and contains new data then the last print job received.

Referring to claim 8, Gacek discloses the information providing system as defined by claim 1 wherein the communication line is a line connected to the Internet (internet 301, Fig. 1).

Referring to claim 9, Gacek discloses an information providing method comprising the steps of: (a) storing, by an information provider, information into an information providing server (col. 9, lines 28-32); (b) by a printer of a customer, acquiring the information stored in said information providing server (S601-S604, Fig. 6A), printing the information on a print medium (col. 15, lines 55-58), and notifying an amount of the printed information to said information providing server (col. 13, lines 9-11); and (c) paying consideration to the customer by the information provider based on the notified amount of information (col. 13, lines 11-16).

Referring to claim 10, Gacek discloses the information providing method as defined by claim 9 wherein said information providing server and said printer are connected via the Internet (internet 301, Fig. 1).

Referring to claim 13, Gacek discloses an information providing system comprising: an information providing server having means for storing information to be

provided to customers (col. 9, lines 28-32); means for setting a printer at a customer so as to acquire the information stored in said information providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58), and to notify an amount of the printed information to said information providing server (col. 13, lines 9-11); wherein said information providing server comprising means for paying the customer by an information provider based on the notified amount of the printed information (col. 13, lines 11-16).

Referring to claim 14, Gacek discloses the information providing system as defined by claim 13 wherein said information providing server and said printer are connected via an Internet (internet 301, Fig. 1).

Referring to claim 18, Gacek discloses a computer readable program product for performing an information providing service (col. 22, lines 13-22), the program product comprising the steps of; (a) storing information to be provided to customers in an information providing server (col. 9, lines 28-32); (b) setting a printer at a customer so as to acquire the information stored in said information providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58), and to notify an amount of the printed information to said information providing server (col. 13, lines 9-11); (c) paying the customer based on the notified amount of the printed information (col. 13, lines 11-16).

4. Claims 1, 11, 12, 15-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls.

Referring to claim 1, Kolls discloses an information providing system comprising: a printer (printer 104); a user terminal (system 500) connected to said printer and sending print information to said printer (block 1408 of Fig. 16, col. 36, lines 34-37); and an information providing server delivering information via a communication line (universal server), wherein said printer comprises: means for acquiring the information delivered from said information providing server, said means for acquiring the information being connected to said information providing server via the communication line (modem control means 512, col. 41, lines 57-63); means for printing the acquired information according to a print instruction received from said user terminal (col. 41, lines 24-28); and means for notifying an amount of information acquired from said information providing server and printed (block 1502, col. 36, lines 55-60), wherein said user terminal comprises: means for sending a print instruction to said printer (col. 41, lines 24-28); and means for setting a print format of the information, which is acquired from said information providing server (col. 41, lines 57-63), in said printer, and wherein said information providing server comprises: means for calculating a total of the amount of information notified by said printer (block 1504, col. 36, lines 62-66). The coupon data disclosed by Kolls can include data accessible by system 500 (col. 41, lines 57-63). With modem control means 512, coupon data can consist of information from the server. Kolls discloses that printed data can consist of information obtained from PC 630 (col. 35, lines 60-66). By using a computer, the user can control the print format of the information.

Referring to claim 11, Kolls discloses an information providing method comprising the steps of: (a) storing, by an information provider, information into an information providing server (col. 41, lines 57-63); (b) lending printer from the information provider to a customer (col. 17, lines 42-55); (c) by said Printer, acquiring the information stored in said information providing server (block 1408, col. 36, lines 33-35), printing the information on a print medium (col. 36, lines 46-50), and notifying an amount of the printed information to said information providing server (block 1502, col. 36, lines 55-60); and (d) collecting, by the information provider, an amount of value corresponding to a rental charge of said printer from the customer based on the notified amount of information (block 1504, col. 36, lines 62-64).

Referring to claim 12, Kolls discloses the information providing method as defined by claim 11 wherein said information providing server and said printer are connected via the Internet (col. 6, lines 29-32).

Referring to claim 15, Kolls discloses an information providing system comprising: an information Providing server having means for storing, by an information provider, information to be provided to customers (col. 41, lines 57-63); means for registering a printer lent from the information provider to a customer (col. 17, lines 42-55); means for setting said printer so as to acquire the information stored in said information providing server (block 1408, col. 36, lines 33-35), to print the acquired information (col. 36, lines 46-50), and to notify an amount of the printed information to said information providing server (block 1502, col. 36, lines 55-60); and means for



collecting a rental charge of said printer from the customer based on the notified amount of information (block 1504, col. 36, lines 62-64).

Referring to claim 16, Kolls discloses the information providing system as defined by claim 15 wherein said information providing server and said printer are connected via an Internet (col. 6, lines 29-32).

Referring to claim 17, Kolls discloses the information providing system as defined by claim 15, wherein said means for setting the printer includes a program which performs said setting through being accessed by said printer (col. 5, lines 2-4).

Referring to claim 19, Kolls discloses a computer readable program product for performing an information providing service (col. 5, lines 2-4), the program product comprising the steps of; (a) storing information to be provided to customers in an information providing server (col. 41, lines 57-63); (b) registering a printer lent from an information provider to a customer (col. 17, lines 42-55); (c) setting said printer so as to acquire the information stored in said information providing server (block 1408, col. 36, lines 33-35), to print the acquired information (col. 36, lines 46-50), and to notify an amount of the printed information to said information providing server (block 1502, col. 36, lines 55-60); and (d) collecting an amount of value corresponding to a rental charge of said printer from the customer based on the notified amount of the printed information (block 1504, col. 36, lines 62-64).

Referring to claim 20, Kolls discloses the program product as defined by claim 19, wherein said amount of value corresponds to a rental charge less an amount associated with the notified amount of the printer information (col. 40, lines 36-41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls as applied to claim 1 above, and further in view of Massarsky.

Kolls discloses the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in the print margin. Massarsky discloses inserting advertisements onto printed photographs at photo-booths (col. 6, lines 49- 56). The location of the advertisement is shown as with the print margin (Fig. 5A). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls into the print margin as disclosed by Massarsky. One of ordinary skill in the art would have been motivated to do this to keep the dimensions of the printing area of the internet based data while allowing an advertisement to be inserted into the printed material.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls as applied to claim 1 above, and further in view of Massarsky and Muramatsu et al.

Kolls, Massarsky, and Muramatsu et al. disclose the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in the print margin. Massarsky discloses inserting advertisements onto printed photographs at photo-booths (col. 6, lines 49- 56). The location of the advertisement is shown as with the print margin (Fig. 5A). Massarsky does not expressly disclose reducing the print field of the information to produce a print margin. Muramatsu et al. discloses a printing method of reducing the size of printing material (Fig. 29, col. 22, lines 42-44). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to produce a print margin with the printing method disclosed by Muramatsu, insert an advertisement into printed material as disclosed by Massarsky, and combine coupons with internet based data as disclosed by Kolls. One of ordinary skill in the art would have been motivated to do this to allow a greater area for coupons to be inserted into printed internet based data and to make the items being printed better fit into the document.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls as applied to claim 1 above, and further in view of Freedman.

Kolls discloses the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer combines the information acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in blank portions of the document. Freedman discloses inserting advertisements into blank portions of printed material (col. 10, lines 11-14). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls into blank portions of printed material as disclosed by Freedman. One of ordinary skill in the art would have been motivated to do this to efficiently allow coupons to be inserted into printed internet based data without wasting paper space.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls as applied to claim 1 above, and further in view of DeBruin-Ashton.

DeBruin-Ashton discloses the information providing system as defined by claim 1 wherein said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing on the reverse side of the document. DeBruin-Ashton discloses inserting advertisements onto the other side of printed material (Fig. 3A and Fig. 3B, col. 13, lines 48-53). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls onto both sides of printed material as disclosed by DeBruin-Ashton. One of ordinary skill in the art would have been motivated to do this to allow utilizing both sides of a page and eliminate wasted paper space for inserting coupons onto printed internet based data.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawai et al. U.S. Patent No. 6,404,994 discloses an image forming apparatus system that inserts advertisements into photocopies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (703)306-4088. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



JOSEPH MANCUSO  
PRIMARY EXAMINER